

Appl. No. 09/632,774

Office Action Dated January 25, 2005

Amendment Dated February 23, 2005

REMARKS

Claims 7, 11 and 15 have been amended, no claims have been canceled, and no new claims have been added. Claims 1-25 are therefore pending.

Double Patenting

The Final Office Action objects to Claim 8 as being a substantial duplicate of claim 1 under 37 CFR 1.75. Claim 7 upon which claim 8 depends has been amended to overcome this objection.

Claim 1 recites that a sponsorship object includes "a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label." In contrast, amended claim 7 recites that the sponsorship object only includes "a sponsorship object including a resource locator associated with a sponsorship label to be displayed." The reference to a "a hypertext link associated with a resource locator to be accessed if a user clicks on the sponsorship label" has been amended to recite "a hypertext link to be accessed if a user clicks on the sponsorship label." As such, claim 1 recites that the sponsorship object includes two resource locators while amended claim 7 recites that the sponsorship object includes a single resource locator. It follows that by virtue of its dependency on claim 7, claim 8 is distinct from claim 1. Therefore, we request that the double patenting objection be withdrawn.

Claim Rejections - 35 USC § 102

The Office Action recites the earlier rejection of claims 11-14 under 35 USC § 102(e) as anticipated by Angles (US 5, 933,811). Claim 11 has been amended. The amendments include limitations included in the specification which we thought would be read into the claims. The amendments recite that "the client window displayed independently of and concurrently with a browser window generated by an Internet browser." As the Examiner did not interpret the claims in view of the specification, the current amendments were made to add limitations recited in the specification. No new matter has been added.

We request that the Examiner reconsider this rejection in view of amended claim 11. Angles fails to teach a client window and browser window as recited in the claims and is instead focused on the consumer browser module 40, a web browser. (Angles, Figs. 4 and 11; col. 8, line 45 - col. 8,

Appl. No. 09/632,774

Office Action Dated January 25, 2005

Amendment Dated February 23, 2005

line 19; col. 10, lines 43-59) The Office Action admits that "Angles does not explicitly disclose that the advertisement is being displayed in a window independent of the browser window by the client application operating independently of the browser." (p. 6, lines 5-7 of the Office Action) Because Angles fails to teach each and everyone of the limitations recited in claim 11, claim 11 and all claims dependent thereon are patentable over Angles.

Claim Rejections - 35 USC § 103

The Final Office Action rejects claims 1-5, 7-10, 15-19, and 21-25 under 35 USC § 103(a) unpatentable over the combination of Angles and Petrecca (USP 5,781,894). Claims 1, 7, 15 and 21 are independent claims. Claim 15 has been amended to more clearly recite the features claimed. As independent claim 11 has been amended to recite limitations similar to some of the limitations recited in the other independent claims, claim 11 will be prospectively included in the argument concerning the 35 USC 103(a) rejection citing Angles and Petrecca in an effort to move prosecution of this application forward. The independent claims - claims 1, 7, 11, 15 and 21 - are patentable over the combination of Angles and Petrecca for the reasons set forth below.

The Office Action admits that "Angles does not explicitly disclose that the advertisement is being displayed in a window independent of the browser window by the client application operating independently of the browser." (p. 6, lines 5-7 of the Office Action) The Office Action asserts that Petrecca teaches this limitation at col. 2, line 60 – col. 3, line 3. We respectfully disagree.

Claim 1 recites a "client application accessing an online server associated with the online service and providing interaction with the online service" the "client application operating independently of an Internet browser and operating concurrently with the Internet browser" and a "client window displayed independently of a browser window generated by the Internet browser." The other independent claims recite limitations similar to or the same as one or more of these limitations. Petrecca does not recite these limitations.

Petrecca teaches that an

advertising system and method exist as an independent software application which runs in the background similar to the strategy of the popular screen savers. The advertising system and method is configured to over-ride the screen saver program and present advertising messages after a specified

Appl. No. 09/632,774

Office Action Dated January 25, 2005

Amendment Dated February 23, 2005

time period has transpired without input [sic] from the user. Alternatively, the advertising system and method is configured to detect waiting time periods and to present the advertising messages only during this time. (Petrecca, col . 2, line 60 – col. 3, line 3, emphasis added)

Petrecca is directed to an independent advertising software application that presents advertisements when a user is inactive for a period of time and/or during user down time. (Petrecca, Abstract; col . 2, line 60 – col. 3, line 3) Petrecca fails to teach or suggest a “client application accessing an online server associated with the online service and providing interaction with the online service” the “client application operating independently of an Internet browser and operating concurrently with the Internet browser” and a “client window displayed independently of a browser window generated by the Internet browser” as recited in claim 1.

Petrecca merely teaches an independent software system for displaying advertisements. But Petrecca fails to teach or suggest a client application that accesses an online server and provides interaction with the online service as claimed. As such, the combination of Petrecca and Angles fail to teach or suggest all of the limitations recited in claim 1. Claims 7, 11, 15 and 21 recite the same or similar limitations. More specifically, claims 11 and 15 recite “software for causing a local device to: a) commence an online session with the online server through which the user utilizes the online service.” There is no teaching or suggestion of this functionality in Petrecca. Therefore, all of the independent claims are patentable over the combination of Petrecca and Angles. By virtue of their dependency on claims 1, 7, 11, 15 and 21, claims 2-5, 8-10, 12-14, 16-19, and 22-25 are patentable over the combination of Petrecca and Angles.

The Office Action rejects claims 6 and 20 under as being unpatentable over Angles, Petrecca and Filepp (US 5,347,632) Claims 6 and 20 are ultimately dependent on claims 1 and 15. Claims 1 and 15 are discussed above regarding the combination of Angles and Petrecca. For the same reasons claims 1 and 15 are patentable over the combination of Angles and Petrecca as set forth above, by virtue of their dependency on these claims, claims 6 and 20 are not rendered obvious by and are patentable over the combination of Angles and Petrecca. Filepp fails to cure the deficiencies of claims 1 and 15 discussed above. The combination of Angles, Petrecca and Filepp fail to teach or

Appl. No. 09/632,774

Office Action Dated January 25, 2005

Amendment Dated February 23, 2005

suggest the limitations recited in claims 6 and 20. As such, claims 6 and 20 are not rendered obvious by and are patentable over the combination of Angles, Petrecca and Filepp.

Conclusion

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions and to discuss steps necessary for placing the claims in condition for allowance.

Respectfully submitted,

Date: February 23, 2005



Mark A. Goldstein

Reg. No. 50,759

SoCal IP Law Group
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350 x240
Facsimile: 805/230-1355
mgoldstein@socalip.com